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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,051	08/31/2000	Gerald Francis McBrearty	AUS000412US1	2784

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EXAMINER	
CAMPBELL, JOSHUA D	
ART UNIT	**PAPER NUMBER**
2178	

DATE MAILED: 01/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/652,051	MCBREARTY ET AL.	
	Examiner	Art Unit	
	Joshua D Campbell	2178	

-- Th MAILING DATE of this communication app ars on th cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 August 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 4-6, 8-13, 14, 16-17, 19, and 21-22* is/are rejected.

7)☒ Claim(s) *3, 7, 15, 18, 20, and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 August 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

1. This action is responsive to communications: Application filed on 08/31/2000.

2. Claims 1-23 are pending in this case. Claims 1, 8, 14, and 19 are independent claims.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3, 8, 10-11, 14-15, and 19-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 7 of U.S. Patent No. 6,661,432. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art at the time the invention was made to display an item that is being searched for once it is found, in the case of a web site search displaying a web page that contains the found item.

Allowable Subject Matter

5. Claims 7, 18, and 23 are objected to as being dependent upon rejected base claims, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 3, 15, and 20 would be allowable if re-written in independent form and upon the filing of a proper terminal disclaimer.

Claim Objections

7. Claims 15-18 and 20-23 objected to because of the following informalities: Claims 15-18 appear to be dependent on claim 14 but are listed as being dependent on claim 13. Claims 20-23 appear to be dependent on claim 19 but are listed as being dependent on claim 19. Appropriate correction is required.

For the purpose of further examination, claims 15-18 are viewed as being dependent on claim 14, and claims 20-23 are viewed as being dependent on claim 19.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-5, 8-13, 14, 16-17, 19, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins (US Patent Number 6,253,198, filed on May 11, 1999) in view of Google ("Googles New GoogleScout Feature Expands Scope of Search on the Internet", September 21, 1999).

10. **Regarding independent claim 1,**

- searching a web page for a hidden search engine identifier;
    - Perkins discloses a method in which a web page is searched for a search identifier (robots.txt) which discloses which search engines (if any) may index the page (column 2, lines 25-54 of Perkins).
- displaying the search engine identifier;
    - Perkins discloses a method in which the identifier file is analyzed once it is found but does not disclose displaying the file. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have displayed the identifier file as is was being analyzed so the user could view which search engines had access to the web-site.

11. **Regarding dependent claim 2,**

- opening a second web page corresponding to the search engine identifier;
    - Perkins does not disclose a method in which a second page is opened in reference to the search engine identifier. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have opened the web-page of the search engine the identifier was pointing to in order to gain access to the search engine so the user could view and use the search engine that was identified.

12. **Regarding dependent claim 4,**

- displaying a search entry screen in response to the searching failing to find the search engine identifier;
- receiving a search request from the user;
- searching a plurality of pages from a web site for the search request, wherein the web site contains the web page;
- providing a selectable search result screen in response to searching the plurality of pages;
    - Perkins does not disclose an input screen for receiving a request that is then sent to an engine in response to not finding a search identifier. However, Google teaches a method in which an input screen is displayed from which a search request may be received from the user. Google also teaches a SiteSearch system which directs a search towards a specific site, which is prepared for the use of that engine, and results are displayed

on a webpage in link format with annotations (Page 3, "Google Search Services" of Google). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Perkins with the engine of Google because it would have provided a more efficient search engine to be pointed to by the identifier shown by Perkins. Neither Google nor Perkins disclose showing the input screen in response to not finding an identifier. However, it would have been obvious to one of ordinary skill in the art to provide the input screen when an identifier was not found because it would be redundant to provide the search engine to a site that already contained one.

13. **Regarding dependent claim 5,**

- identifying a hidden HTML tag within the web page, wherein the hidden HTML tag includes the search engine identifier;
    - o Perkins discloses a method in which a tag found in an HTML document contains the information for a search engine identifier (column 2, lines 44-66 of Perkins).

14. **Regarding independent claim 8,**

- determining whether the web site has an associated search engine;
    - o Perkins discloses a method in which a web page is searched for a search identifier (robots.txt) which discloses which search engines (if any) may index the page (column 2, lines 25-54 of Perkins).
- allowing access to the search engine from the web page;

- Perkins does not disclose a method in which a web page to the identified search engine is opened. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have opened the search engine page was the engine was identified in order to allow a search to be performed.

15. **Regarding dependent claim 9,**

- accessing the search engine;
  - Perkins does not disclose a method in which a web page to the identified search engine is opened. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have opened the search engine page was the engine was identified in order to allow a search to be performed.

16. **Regarding dependent claim 10,**

- displaying an input screen;
- receiving a search request;
- sending the search request to the search engine;
  - Perkins does not disclose an input screen for receiving a request that is then sent to an engine. However, Google teaches a method in which an input screen is displayed from which a search request may be received from the user. Google also teaches a SiteSearch system which directs a search towards a specific site which is prepared for the use of that engine (Page 3, "Google Search Services" of Google). It would have been

obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Perkins with the engine of Google because it would have provided a more efficient search engine to be pointed to by the identifier shown by Perkins.

17. **Regarding dependent claims 11-13,** the claims contain substantially similar subject matter as claims 1, 2, and 5. Thus, the claims are rejected along the same rationale as claims 1, 2, and 5.

18. **Regarding independent claims 14 and 19,**

- one or more processors;
- a memory accessible by the processors;
- a nonvolatile storage device accessible by the processors;
- a network interface connecting the information handling system to a computer network;
    - Perkins does not disclose a method in which a system used contains the above components. However, Perkins does disclose a method in which a computer system connected to the internet is used to perform the method (column 7, lines 6-11 of Perkins). One of ordinary skill in the art at the time the invention was made would have known that a computer system connected to the internet would inherently contain these components.
- a search engine location tool, the search engine location tool including:
- means for receiving a request from a user;
- means for searching a web page for a search engine identifier;

- means for opening a web page corresponding to the search engine identifier;
    - Perkins discloses a method in which a web page is searched for a search identifier (robots.txt) which discloses which search engines (if any) may index the page (column 2, lines 25-54 of Perkins). Perkins does not disclose a method in which a request initiates the search or that a second page is opened in reference to the search engine identifier. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have opened the web-page of the search engine the identifier was pointing to in order to gain access to the search engine so the user could view and use the search engine that was identified. It would have also been obvious to one of ordinary skill in the art at the time the invention was made that for the computer system claimed by Perkins to initiate the method some form of request would be necessary.

19. **Regarding dependent claims 16-17 and 21-22,** the claims contain substantially similar subject matter as claims 4-5. Thus, the claims are rejected along the same rationale as claims 4-5.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perkins (US Patent Number 6,253,198, filed on May 11, 1999) as applied to claim 1 above, and further in view of Netscape (Netscape Navigator Gold Version 3.01 Gold, 1996).

20. **Regarding dependent claim 6,**

- receiving a request from the user, wherein the receiving further includes selecting a menu option from a web browser window;
    - Perkins does not disclose receiving a request to search by selecting a menu option. However, Netscape discloses a method in which a search is requested by selecting the "Net Search" tab in the menu (Page 1 – Figure, Netscape). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Perkins with the method of Netscape because it would have allowed a more convenient way to access the search tool.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 6,336,116, filed by Brown et al.

US Patent Number 6,138,129, filed by Combs.

US Patent Number 5,864,845, filed by Voorhees et al.

US Patent Number 6,338,059, filed by Fields et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

JOSEPH H. FEILD
PRIMARY EXAMINER

jdc